



PATENT
Attorney Docket No. 09700.0062
SAP Reference No. 2003P00323 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Johannes LAUTERBACH et al.) Group Art Unit: 2179
Application No.: 10/676,364) Examiner: Augustine, Nicholas
Filed: September 30, 2003) Confirmation No.: 3223
For: DEVELOPING APPLICATIONS)
USING A METAMODEL)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the 35 U.S.C. § 102(b) rejection in the Final Office Action mailed August 23, 2007, the period for response having been extended through January 23, 2008 by a petition for extension of time for two months and fee payment filed concurrently herewith. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

In the Final Office Action, the Examiner rejected claims 1-22 under 35 U.S.C. § 102(b) as being anticipated by the combination of "Using the SNAP Development Environment" ("SNAP"), "Using the WFT Development Document" ("ENV"), and

“Developing a WFT Workflow System” (“WFT”).¹ Applicants respectfully traverse the rejection.

First, Applicants submit that the Examiner’s use of multiple references in support of the rejection under § 102(b) is improper.

A person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States

35 U.S.C. § 102 (emphasis added). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131, 8th Ed., Rev. 6 (September 2007), quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). *SNAP*, *ENV*, and *WFT* are not a single printed publication or a single prior art reference. These references even have different publication (release) dates. Therefore, this rejection is based on multiple references.

Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an “enabled disclosure;”
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

M.P.E.P. § 2131.01, 8th Ed., Rev. 6 (September 2007). However, the Examiner did not combine the multiple cited references for any of the three reasons (i.e., (A), (B), or (C)) listed in M.P.E.P. § 2131.01.

¹ The Examiner cited numerous references but only three of those references, namely, *SNAP*, *ENV*, and *WFT*, were used to support the § 102(b) rejection.

Instead, the Examiner argues that the multiple references “constitute a single reference” (Final Office Action at 5) because “the three software modules [described separately in the three references] were part of a single software package offering and that they work together[,] . . . has been designed to seamlessly integrate and inter-operate with all of the others[,] . . . and . . . are designed to be used together” (Final Office Action at 11). However, the Examiner has no legal basis (in statute or from case law) for stating that multiple references constitute a single reference for purposes of 35 U.S.C. § 102 when the references disclose software modules that are allegedly offered as a single software package or are allegedly designed to integrate with one another and used together.

Therefore, the multiple references, *SNAP*, *ENV*, and *WFT*, cannot be combined to support a rejection under 35 U.S.C. § 102(b). Accordingly, Applicants respectfully object to the use of multiple references in support of the rejection under 35 U.S.C. § 102(b). Applicants, nonetheless, argue the merits of this rejection below.

In order to properly establish that the prior art anticipates Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Even assuming that *SNAP*, *ENV*, and *WFT* could be considered a single reference, which

Applicants do not concede, such a “reference” does not teach or suggest each and every element of Applicants’ claims.

Independent claim 1 recites a combination including, for example, “a model class associated with the component class, the model class including a model-class class.” The cited references do not teach or suggest at least these elements of claim 1.

The Examiner alleges page 4-4 and pages 4-10 to 4-14 of *SNAP* teach the claimed “model class,” “component class,” and “model-class class.” Final Office Action at 5-6. However, this is not correct.

Nothing on pages 4-4 and 4-10 to 4-14 of *SNAP* can correspond to the claimed “model class,” “component class,” and “model-class class.” Moreover, even if classes in the cited portions of *SNAP* could correspond to the claimed “model class,” “component class,” and “model-class class” (which they cannot), *SNAP* fails to teach a “model class associated with the component class” and a “model class including a model-class class,” as required by claim 1. Moreover, *ENV* and *WFT* also fail to teach the claimed elements and relationships between elements. Therefore, the cited references fail to teach or suggest all the elements of claim 1. For at least these reasons, the cited references fail to anticipate claim 1.

Independent claims 13 and 16, although different in scope from claim 1, are allowable over the cited references for at least reasons similar to those given for claim 1. In addition, dependent claims 2-12, 14, 15, and 17-22 are allowable over the cited references at least by virtue of their dependence from allowable base claims 1, 13,

and 16. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-22 under 35 U.S.C. § 102(b).

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

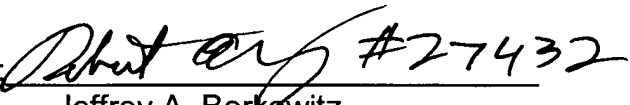
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 17, 2008

By:

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